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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91125615
Party	Plaintiff UNIVERSITY OF SOUTHERN CALIFORNIA
Correspondence Address	SCOTT A. EDELMAN GIBSON DUNN & CRUTCHER, LLP 2029 CENTURY PARK EAST, STE. 4000 LOS ANGELES, CA 90067-3026
Submission	Motion to Amend Pleading/Amended Pleading
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Signature	/pfw/
Date	06/11/2004
Attachments	amend_no.pdf (15 pages)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

University of Southern California

Opposer,

v.

University of South Carolina,

Applicant.

Opposition No. 91125615

Serial No.: 75/358,031

Filed: September 16, 1997

Published: May 18, 1999

Mark: "SC" (Stylized)

Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

Motion to Amend Notice Of Opposition

Opposer hereby moves to amend its Notice of Opposition under Fed. R. Civ. P. 15(a) and 37 CFR § 2.107. A signed copy of the proposed Amended Notice of Opposition is attached hereto.

Opposer's proposed Amended Notice of Oppositions does two things. First, it makes it absolutely clear that Opposer relies on its common law rights in its "SC" mark, and in particular on its "SC" mark presented in the stylizations termed the Baseball Interlock and the SC Interlock as described in its motion for summary judgment. Second, it adds Opposer's Federal Registration No. 2683137 to this proceeding. That registration—also mentioned in Opposer's summary judgment motion—issued on February 4, 2003, well after Opposer filed its original Notice of Opposition, and so Opposer can only present it in this proceeding in an amended complaint. Each of these additions are of the type approved by the Trademark Board Manual of

Procedure and controlling authority, and the proposed Amended Notice of Opposition will not unfairly prejudice the Applicant.

Applicant probably does not *need* to amend its complaint to refer to its common law rights (in particular, in the Baseball Interlock and the SC Interlock stylizations), as the original Notice of Opposition generally includes Opposer's ownership of its "SC" mark. An opposer can show how it uses its mark to prove that an applicant's mark is likely to confuse consumers.¹ Still, this amendment is justified (and supported) by comments in the Board's April 29, 2004 Order on Opposer's Summary Judgment Motion (the "Order"). Although the Board noted that Opposer does not expressly claim common law rights of any interlocking representation of an SC mark, the Board construed the Notice of Opposition to encompass Opposer's claim of common law rights in the Baseball Interlock and SC Interlock Marks. *See* Order, p. 2, lines 15-17; p. 5, fn. 5. Yet the Board qualified its construction by noting that it was "for purposes of summary judgment." *Id.* at p. 5, fn. 5. The proposed amendment resolves any ambiguity by affirmatively pleading Opposer's common law rights in its Interlock Marks. This will benefit both parties and the Board by focusing this proceeding on the merits rather than on procedural issues. Likewise, the proposed Notice of Opposition's adding Registration No. 2683137 is just the sort of the amendment contemplated by the rules. Indeed, the Board liberally grants motions to amend to add a registration acquired after the filing of the original complaint. TBMP § 507.02 (citing cases).

¹ *See, e.g.*, 15 U.S.C. 1052(d), which forbids registration of a mark that so resembles a mark "previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive." The Board must consider what the previously used mark looks like in order to determine if confusion is likely.

The proposed amended pleading is especially appropriate since this proceeding is still in the pretrial stage. As an expert commentator has noted, and the Board has approvingly cited, "if the Board proceeding is still in the pre-trial stage (i.e., in discovery, or prior to any testimony having been taken by the plaintiff in its testimony period), leave to amend, if otherwise appropriate, will be allowed."² As set by the Board's Order, discovery does not close until September 1, 2004. Moreover, Applicant has been on notice that Opposer relies on its Baseball Interlock and SC stylizations as well as its Registration No. 2683137 at least since Opposer filed its summary judgment motion on October 15, 2003. Since Applicant has long been aware of Opposer's claims in the Amended Notice of Complaint and will have more than ample time to prepare its case for trial, the proposed amendment does not prejudice Applicant.

Consistent with the language of Fed. R. Civ. P. 15(a) and the federal cases that have interpreted it, "[t]he Board has granted leave to amend pleadings with considerable liberality where the amendment does not violate settled law and the circumstances are such that the adverse party is not prejudiced thereby."³

² Beth A. Chapman, *TIPS FROM THE TTAB: Amending Pleadings: The Right Stuff*, 81 Trademark Rep. 302, 305 (1991).

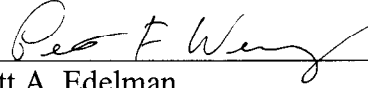
³ *Id.*

The proposed Amended Notice of Opposition is supported by the Trademark Board Manual of Procedure and will not prejudice Applicant.

Dated: June 11, 2004

Respectfully submitted,

GIBSON, DUNN & CRUTCHER, LLP

A handwritten signature in cursive script, appearing to read "Peter F. Weinberg", is written over a horizontal line.

Scott A. Edelman

Michael S. Adler

Peter F. Weinberg

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Los Angeles, CA 90067-3026

Telephone: (310) 552-8500

Attorneys for Opposer

University of Southern California

Encls.

Postcard receipt

Amended Notice of Opposition and its Exhibits A - C

Reference no. 93107-00125

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

University of Southern California

Opposer,

v.

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Opposition No. 91125615

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Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

AMENDED NOTICE OF OPPOSITION

Pursuant to Trademark Rule 2.102, University of Southern California, a California non-profit corporation located at University Park, ADM 352, Los Angeles, California 90089, believes that it is and will be damaged by registration of the mark shown in Serial No. 75/358,031 in International Class 25 and hereby opposes the same.

As grounds for opposition, it is alleged that:

1. The applicant, The University of South Carolina, a South Carolina agency, (hereafter "Applicant"), whose business address is believed to be 104 Osbourne Administration Building, Columbia, South Carolina, 29208, seeks to register "SC" (Stylized) as a trademark for clothing, namely, hats, baseball uniforms, T-shirts, and shorts, in International Class 25, claiming a first-use date both anywhere and in interstate commerce of January, 1997 in connection with said mark. The mark was published in the *Official Gazette* of the United States Patent and Trademark Office ("PTO") on May 18, 1999 as Serial No. 75/358,031. This Opposition is timely because a request for an extension of time to oppose the application has been granted by the Trademark Trial and Appeal Board, through and including May 4, 2002.

2. The opposer, University of Southern California (hereafter "Opposer"), is the owner of Federal Registration No. 1,844,953, registered on July 12, 1994, for the mark "SC"

(words only) in connection with numerous goods in International Classes 6, 18, 24, and 25, including sweatshirts and T-shirts in Class 25. Opposer has used its "SC" mark in connection with the registered goods since at least as early as 1926, and has used the mark in commerce since at least as early as 1978 (for goods in Class 6) and at least as early as 1987 (for goods in Classes 18, 24, and 25). Moreover, Opposer's "SC" mark serves as a secondary source for Opposer's famous educational and athletic services. Opposer has used the mark in connection with competitive sporting events and educational services dating back to the late 1800s. Opposer's "SC" mark is a highly distinctive collegiate mark, and through extensive advertising and use, the "SC" mark has become strongly and uniquely associated with Opposer's goods and services. Opposer has priority of use of its "SC" marks when compared with the mark of the subject application. Opposer claims common law rights in its "SC" mark, as well as the rights provided by Opposer's ownership of Registration No. 1,844,953

3. The mark proposed for registration by Applicant in International Class 25, namely, "SC" (Stylized), incorporates in its entirety, and is virtually identical to Opposer's registered "SC" word mark. Furthermore, Applicant's mark is applied to identical goods as those offered by Opposer. In fact, Applicant's mark so nearly resembles Opposer's mark as to be likely to be confused with and mistaken for Opposer's mark. Applicant's mark is deceptively similar to Opposer's mark so as to cause confusion and lead to deception as to the origin of Applicant's goods bearing Applicant's mark. Applicant's use of the "SC" mark in connection with clothing in International Class 25 violates the provisions of Section 43(a) of the federal Trademark Act by implying an affiliation with Opposer's well known business.

4. There is no issue as to priority. Applicant's dates of first use (*i.e.*, January, 1997), are subsequent to Opposer's first use of the mark "SC" in interstate commerce for clothing (*i.e.*, at least as early as 1987), as well as for the other goods and services Opposer markets under its "SC" mark, some of which date back to the late 1800s.

5. Opposer has used its "SC" mark in commerce in the stylization termed the Baseball Interlock, which is shown in Exhibit A hereto, since at least 1994. Opposer has used the Baseball Interlock stylization in connection with various goods, including use on shirts and hats. Opposer claims common law rights in the Baseball Interlock stylization of its "SC" mark.

6. Opposer has used its "SC" mark in commerce in the stylization termed the SC Interlock since at least 1994. Opposer is the owner of Federal Registration No. 2,683,137, registered on Feb. 4, 2003, for the SC Interlock. Registration No. 2,683,137 is for numerous goods and services in International Classes 12, 16, 18, 21, 24, 25, 28, 35 and 41, including in particular for hats, baseball shirts and jerseys, t-shirts, and shorts in Class 25. Opposer claims common law rights in the SC Interlock stylization of its "SC" mark, as well as the rights provided by Opposer's ownership of the Registration No. 2,683,137.

7. Opposer is informed and believes, and therefore alleges that Applicant's use of the mark "SC" commenced after Opposer's use of the mark "SC" in interstate commerce. Moreover, Opposer is informed and believes that Applicant had actual knowledge of Opposer's prior use and rights in the "SC" mark for clothing, as well as other goods and services, prior to filing a federal application to register the mark for clothing.

8. Opposer's "SC" mark is famous, and Applicant's use of the subject mark for the identified goods will dilute the distinctive quality of Opposer's mark, in violation of 15 U.S.C. Section 1125(c). Indeed, Opposer widely and extensively advertises and promotes its university athletics programs and sporting events by selling clothing and other products and services bearing the "SC" mark. Opposer spends a very significant amount of money each year for such advertisement and promotion, which extends throughout the United States and internationally.

9. As a result of such extensive advertisement, promotion, and sale of items bearing "SC," the mark has gained widespread and favorable public acceptance and recognition. "SC" is uniquely associated with, and hence identifies Opposer. Opposer has developed valuable goodwill with respect to the "SC" mark. "SC" is a famous and distinctive mark, and represents an asset of incalculable value as a symbol of Opposer the University of Southern California, its quality goods and services, and its goodwill.

10. If the Applicant is permitted to use and register its mark for the goods specified in the application being opposed herein, the result will be confusion in trade causing damage and injury to the Opposer due to the similarity between Applicant's mark and Opposer's mark. Persons familiar with Opposer's mark will inadvertently purchase Applicant's products, believing the products are Opposer's. Any such confusion in trade inevitably would result in loss of sales by Opposer. Furthermore, any defect, objection or fault found with Applicant's products, marketed under its mark, would necessarily reflect upon and seriously injure the reputation Opposer has established for its "SC" products and services.

11. If Applicant is granted the registration herein opposed, Applicant would thereby obtain at least a *prima facie* exclusive right to use the mark. Such registration would cause damage and injury to Opposer.

12. Two photocopies of registration nos. 1844953 and 2683137 and prepared and issued by the Patent and Trademark Office showing both the current status of and current title to the registrations are attached hereto as Exhibits B and C respectively. Those registrations are therefore in evidence and part of the record of this proceeding under 37 C.F.R. § 2.111(d)(1).

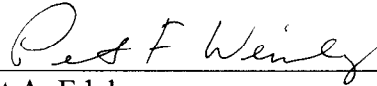
WHEREFORE, Opposer prays that the application Serial No. 75/358,031 be rejected, and that the mark therein sought for the goods specified above in International Class 25 be denied and refused.

No fee is believed to be due herewith, but any necessary fee may be charged to deposit account no. 50-0792.

Dated: June 11, 2004

Respectfully submitted,

GIBSON, DUNN & CRUTCHER, LLP

A handwritten signature in cursive script, appearing to read "Peter F. Weinberg", is written over a horizontal line.

Scott A. Edelman

Michael S. Adler

Peter F. Weinberg

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Attorneys for Opposer

University of Southern California

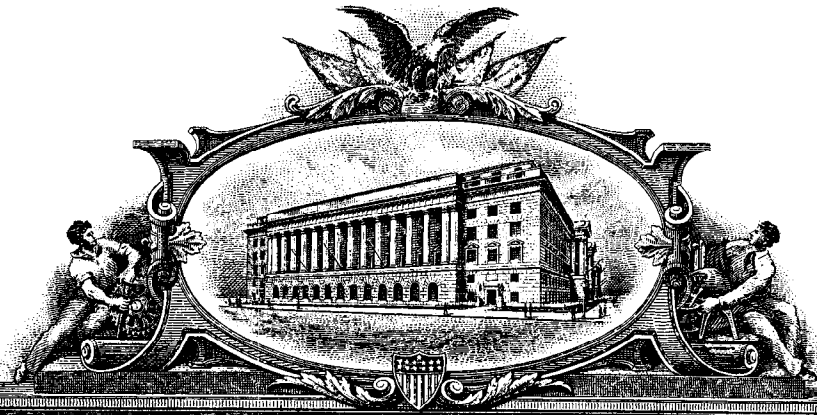
Reference no. 93107-00125

California's Baseball Interlock



Exhibit A

1175334



THE UNITED STATES OF AMERICA

TO ALL TO WHOM THESE PRESENTS SHALL COME:

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

May 25, 2004

**THE ATTACHED U.S. TRADEMARK REGISTRATION 1,844,953 IS
CERTIFIED TO BE A TRUE COPY WHICH IS IN FULL FORCE AND
EFFECT WITH NOTATIONS OF ALL STATUTORY ACTIONS TAKEN
THEREON AS DISCLOSED BY THE RECORDS OF THE UNITED STATES
PATENT AND TRADEMARK OFFICE.**

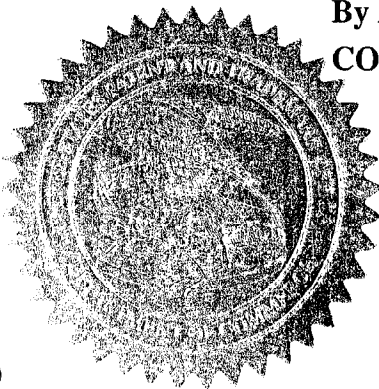
REGISTERED FOR A TERM OF 10 YEARS FROM *July 12, 1994*

SECTION 8 & 15

SAID RECORDS SHOW TITLE TO BE IN:

REGISTRANT

**By Authority of the
COMMISSIONER OF PATENTS AND TRADEMARKS**





N. WILLIAMS

Exhibit B Certifying Officer

Int. Cls.: 6, 18, 24, and 25

Prior U.S. Cls.: 3, 13, 25, 28, 39, 41, 42, and 50

United States Patent and Trademark Office

Reg. No. 1,844,953

Registered July 12, 1994

**TRADEMARK
PRINCIPAL REGISTER**

SC

UNIVERSITY OF SOUTHERN CALIFORNIA
(CALIFORNIA CORPORATION)
UNIVERSITY PARK
LOS ANGELES, CA 90089

FOR: KEYRINGS OF NON-PRECIOUS METALS; DECORATIVE EMBLEMS OR PLATES OF NON-PRECIOUS METAL, FOR ATTACHMENT TO AUTOS; ART WORK STATUARY OF NON-PRECIOUS METALS, ALL GOODS BEING OFFERED AND SOLD TO PERSONS THROUGH UNIVERSITY AUTHORIZED CHANNELS OF TRADE, IN CLASS 6 (U.S. CLS. 13, 25, 28 AND 50).

FIRST USE 0-0-1926; IN COMMERCE 0-0-1978.

FOR: UMBRELLAS, HAND LUGGAGE, TOTE BAGS, LUGGAGE; NAMELY, TOTE BAGS, HAND LUGGAGE, GARMENT BAGS FOR TRAVEL, AND SMALL TRAVELING BAGS FOR OVERNIGHT TRIPS, FANNY PACKS, TOILETRY BAGS SOLD EMPTY, BRIEFCASES, BACK PACKS, ALL GOODS BEING OFFERED AND SOLD TO PERSONS

THROUGH UNIVERSITY AUTHORIZED CHANNELS OF TRADE, IN CLASS 18 (U.S. CLS. 3 AND 41).

FIRST USE 0-0-1926; IN COMMERCE 0-0-1987.

FOR: TOWELS, BLANKETS, CLOTH PENNANTS, AND CLOTH FLAGS, ALL GOODS BEING OFFERED AND SOLD TO PERSONS THROUGH UNIVERSITY AUTHORIZED CHANNELS OF TRADE, IN CLASS 24 (U.S. CLS. 42 AND 50).

FIRST USE 0-0-1926; IN COMMERCE 0-0-1987.

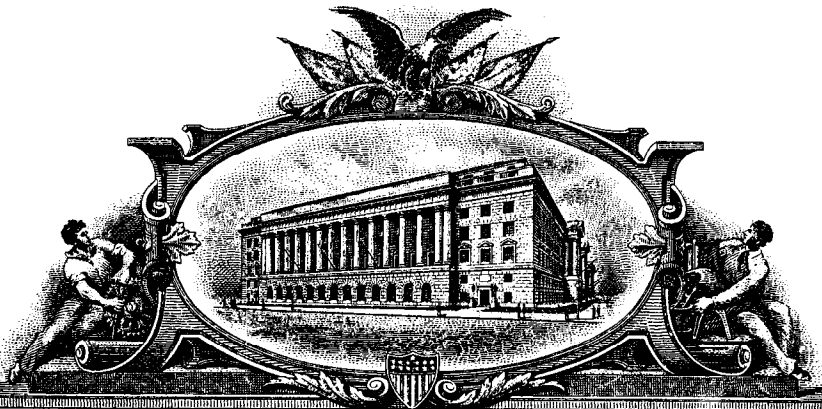
FOR: SWEATSHIRTS AND T-SHIRTS, ALL GOODS BEING OFFERED AND SOLD AT UNIVERSITY-CONTROLLED OUTLETS, IN CLASS 25 (U.S. CL. 39).

FIRST USE 0-0-1926; IN COMMERCE 0-0-1987.

SN 74-094,681, FILED 9-5-1990.

KATHERINE STOIDES, EXAMINING ATTORNEY

1175334



THE UNITED STATES OF AMERICA

TO ALL TO WHOM THESE PRESENTS SHALL COME:

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office

May 25, 2004

THE ATTACHED U.S. TRADEMARK REGISTRATION 2,683,137 IS
CERTIFIED TO BE A TRUE COPY OF THE REGISTRATION ISSUED BY
THE UNITED STATES PATENT AND TRADEMARK OFFICE WHICH
REGISTRATION IS IN FULL FORCE AND EFFECT.

REGISTERED FOR A TERM OF 10 YEARS FROM *February 04, 2003*
SAID RECORDS SHOW TITLE TO BE IN: *Registrant*

By Authority of the
COMMISSIONER OF PATENTS AND TRADEMARKS

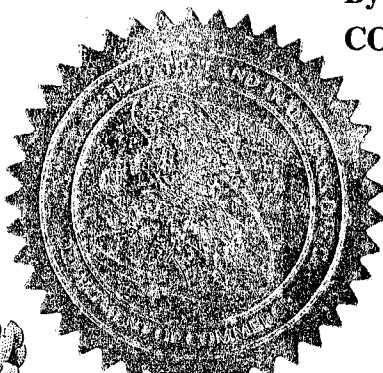


Exhibit C **T. LAWRENCE**
Certifying Officer

Int. Cls.: 12, 16, 18, 21, 24, 25, 28, 35 and 41

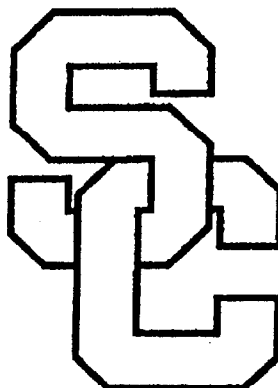
Prior U.S. Cls.: 1, 2, 3, 5, 13, 19, 21, 22, 23, 29, 30, 31, 33, 35, 37, 38, 39, 40, 41, 42, 44, 50, 100, 101, 102 and 107

Reg. No. 2,683,137

United States Patent and Trademark Office

Registered Feb. 4, 2003

TRADEMARK
SERVICE MARK
PRINCIPAL REGISTER



UNIVERSITY OF SOUTHERN CALIFORNIA (CALIFORNIA NON-PROFIT CORPORATION)
UNIVERSITY PARK
ADM 352
LOS ANGELES, CA 900895013

FOR: METAL FRAMES FOR METAL LICENSE PLATES; AND METALLIC CAR EMBLEMS, IN CLASS 12 (U.S. CLS. 19, 21, 23, 31, 35 AND 44).

FIRST USE 0-0-1993; IN COMMERCE 0-0-1994.

FOR: DECALS; FOLDERS; 3-RING BINDERS; PERSONAL ORGANIZERS; CALENDARS; PENCILS; PENS; ERASERS; PENCIL SHARPENERS, PEN OR PENCIL HOLDERS; DESKTOP BUSINESS CARD HOLDERS; NOTE PAPER; WRAPPING PAPER; PAPER NAPKINS; AND PAPER TABLE-CLOTHS, IN CLASS 16 (U.S. CLS. 2, 5, 22, 23, 29, 37, 38 AND 50).

FIRST USE 0-0-1993; IN COMMERCE 0-0-1994.

FOR: UMBRELLAS; LUGGAGE, NAMELY, TOTE BAGS, HAND LUGGAGE, GARMENT BAGS AND OVERNIGHT BAGS; SHOE BAGS FOR TRAVEL; FANNY PACKS; TOILETRY BAGS SOLD EMPTY; BRIEFCASES; BACKPACKS; DUFFEL BAGS; WAL-

LETS; BUSINESS CARD CASES; LUGGAGE TAGS; ANIMAL LEASHES; AND DOG COLLARS, IN CLASS 18 (U.S. CLS. 1, 2, 3, 22 AND 41).

FIRST USE 0-0-1993; IN COMMERCE 0-0-1994.

FOR: PORCELAIN AND GLASS MUGS; CUPS; DRINKING GLASSES; SHOT GLASSES; COMMEMORATIVE AND DECORATIVE PLATES; COASTERS; PAPER PLATES; THERMAL INSULATED CONTAINERS FOR FOOD OR BEVERAGE; PORTABLE BEVERAGE COOLERS; PLASTIC SPORTS BOTTLES SOLD EMPTY; AND PET BOWLS, IN CLASS 21 (U.S. CLS. 2, 13, 23, 29, 30, 33, 40 AND 50).

FIRST USE 0-0-1993; IN COMMERCE 0-0-1994.

FOR: TOWELS; STADIUM BLANKETS; CLOTH PENNANTS; AND CLOTH FLAGS, IN CLASS 24 (U.S. CLS. 42 AND 50).

FIRST USE 0-0-1993; IN COMMERCE 0-0-1994.

FOR: CLOTHING, NAMELY, T-SHIRTS, SWEAT-SHIRTS, POLO SHIRTS, WARM-UP SUITS, JACKETS, RAIN PONCHOS, SWEATERS, JERSEYS, TANK TOPS, SHORTS, SPORT SHIRTS, BASEBALL SHIRTS, BASKETBALL JERSEYS, GOLF SWEA-

TERS, NIGHT SHIRTS, BOXER SHORTS, SOCKS, HATS, CAPS, SPORT CAPS, VISOR CAPS, BEANIES AND TIES, IN CLASS 25 (U.S. CLS. 22 AND 39).

FIRST USE 0-0-1993; IN COMMERCE 0-0-1994.

FOR: SPORTING GOODS, NAMELY, BASEBALLS, FOOTBALLS, GOLF BALLS, GOLF TEES, GOLF BAGS, PUTTERS, GOLF CLUB COVERS, RACKET COVERS, FLYING DISCS, AND FOAM FINGERS; ARCADE-TYPE ELECTRONIC VIDEO GAMES; PLAYTHINGS, NAMELY, PLUSH TOYS, AND RIDE-ON TOYS; PLAYING CARDS, IN CLASS 28 (U.S. CLS. 22, 23, 38 AND 50).

FIRST USE 0-0-1993; IN COMMERCE 0-0-1994.

FOR: ON-LINE RETAIL STORE SERVICES FEATURING MEN'S, WOMEN'S AND CHILDREN'S CLOTHING, FOOTWEAR, HATS, ACCESSORIES,

SPORTING GOODS, GIFTS AND NOVELTY ITEMS, IN CLASS 35 (U.S. CLS. 100, 101 AND 102).

FIRST USE 0-0-1993; IN COMMERCE 0-0-1994.

FOR: ENTERTAINMENT SERVICES, NAMELY, CONDUCTING ATHLETIC COMPETITIONS; ORGANIZING INTERCOLLEGIATE, COMMUNITY AND NATIONAL SPORTING AND CULTURAL EVENTS; SPORTS INSTRUCTION; AND PROVIDING MUSICAL, BAND, DANCE, THEATRICAL AND DRAMATIC PERFORMANCES, IN CLASS 41 (U.S. CLS. 100, 101 AND 107).

FIRST USE 0-0-1993; IN COMMERCE 0-0-1994.

OWNER OF U.S. REG. NO. 1,844,953.

SER. NO. 76-374,729, FILED 2-22-2002.

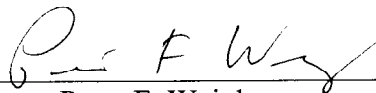
CHRISTINE COOPER, EXAMINING ATTORNEY

Opposition No. 91125615

Certificate of Service

I hereby certify that a true and correct copy of the foregoing **Motion to Amend Notice Of Opposition** and **Amended Notice of Opposition** is being mailed via United States mail, first class, postage prepaid addressed to the following on this June 11, 2004.

John C. McElwaine
Matthew D. Patterson
Nelson Mullins Riley & Scarborough, L.L.P.
Liberty Building, Suite 500
Charleston, SC 29401



Name: Peter F. Weinberg

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